REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed November 16, 2004. Through this response, claims 1, 6, 7, 11, 13, 17, and 21-23 have been amended, and claims 29-36 have been canceled without prejudice, waiver, or disclaimer. Reconsideration and allowance of the application and pending claims 1-28 are respectfully requested.

I.   Claim Rejections - 35 U.S.C. § 102(e)

A.   Statement of the Rejection - Claims 7, 8, and 10

Claims 7, 8 and 10 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by *Smith et al.* ("*Smith*," U.S. Pat. No. 6,192,407). Applicants respectfully traverse this rejection.

B.   Discussion of the Rejection

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)(emphasis added). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

Independent Claim 7

As provided in independent claim 7, Applicants claim (emphasis added):

7.   A method for making a document that is stored on a remote server to be accessible on the Internet according to a temporary document address assigned to the document, the method comprising the steps of:
        issuing a request to the remote server to retrieve a document configured for one-time use; and

receiving a temporary document address from the remote server, wherein the document is accessible on the Internet according to the temporary document address assigned to the document; and

communicating the received temporary document address to a remote Internet appliance, wherein the Internet appliance retrieves the document from the remote server according to the received temporary document address.

Not every feature of independent claim 7 is represented in the *Smith* reference. In particular, *Smith* does not disclose "issuing a request to the remote server *to retrieve a document configured for one-time use*, as recited in independent claim 7. The system in *Smith* describes a private uniform resource locator (PURL) that is temporary, dynamically generated, and that uniquely identifies the intended recipient of a document and the document itself. (see col. 15, lines 9-15). In particular, *Smith* states that the "server dynamically generates a URL for each intended recipient of the document." (see col. 15, lines 32-34; emphasis added). Clearly, the document is not configured for *one-time use* if more than a single user can access it. The ability to provide multiple access to the document is consistent with one of *Smith*'s stated purpose, which is to "distribute electronic portable high content-quality documents to many recipients in a controlled, economical and accountable fashion..." (see col. 2, lines 15-18). Since *Smith* does not disclose all of the features of claim 7, Applicants respectfully submit that the rejection to claim 7 be withdrawn.

Because independent claim 7 is allowable over *Smith*, dependent claims 8-10 are allowable as a matter of law for at least the reason that the dependent claims 8-10 contain all elements of their respective base claim. See, *e.g.*, *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

II.   Claim Rejections - 35 U.S.C. § 102(e)/103(a)

A.   Statement of the Rejection - Claims 11-13, 16-18, 20-23 and 26-36

Claims 11-13, 16-18, 20-23 and 26-36 have been rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as allegedly obvious over *Smith*. Applicants respectfully traverse these rejections.

B.   Discussion of the Rejection

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983)(emphasis added). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

Further, with regard to obviousness rejections, as has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a proper case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Accordingly, to make a proper case for obviousness, there must be a prior art teaching or established knowledge that would suggest to a person having ordinary skill in the pertinent art to fill the voids apparent in the applied reference. It is respectfully asserted that no such case has been made in the outstanding Office Action.

Independent Claims 11, 17, 22, and 27

As provided in independent claims 11, 17, 22, and 27, Applicants claim (emphasis added):

11. A method for making a document available on the Internet according to a dynamically assigned single-use document address, comprising the steps of:

generating a request to a web server for the document from a requesting device;

retrieving the document from a storage location upon receipt of the request;

configuring the retrieved document for one-time use;

sending a single-use document address to the requesting device, wherein the single-use document address is communicated to an Internet appliance;

downloading the retrieved document from the web server according to the single-use document address; and

terminating the single-use document address after downloading the retrieved document.

17. A system to deliver an electronic document to a remote Internet appliance, comprising:

logic configured to receive a request for the document from a requesting source;

logic configured to configure the document for a single use;

logic configured to send the document to the remote Internet appliance upon receipt of a request for the document via an assigned single-use document address; and

logic configured to delete the single-use document address assigned to the requested document after the requested document has been sent to the remote Internet appliance.

22. A system for making a document available on the Internet according to a dynamically assigned single-use document address, comprising:

logic configured to generate a request to a web server for the document from a requesting device;

logic configured to implement the web server to retrieve the document from a secure storage location upon receipt of the request;

logic configured to implement the web server to configure the retrieved document for one-time use;

logic configured to implement the web server to send a single-use document address to the requesting device;

logic configured to implement the requesting device to communicate the single-use document address to an Internet appliance;

logic configured to implement the Internet appliance to download the retrieved document from the web server according to the single-use document address; and

logic configured to implement the web server to terminate the single-use document address after downloading the retrieved document to the Internet appliance.

27.   A system for making a document available on the Internet according to a dynamically assigned single-use document address, comprising:

means for requesting the document;

means for retrieving the document from a secure storage location upon receipt of the request;

means configuring the retrieved document for single-use;

means for downloading the retrieved document according to a single-use document address; and

means for terminating the single-use document address after downloading the retrieved document.

Independent Claim 11

With regard to independent claim 11, Applicants respectfully submit that *Smith* does not disclose, teach, or suggest ***configuring the retrieved document for one-time use***, as recited in claim 11. *Smith* states that the "server dynamically generates a URL for each intended recipient of the document." (see col. 15, lines 32-34; emphasis added). Clearly, the document is not configured for ***one-time use*** if more than a single user can access it.   The ability to provide multiple access to the document is consistent with one of *Smith*'s stated purpose, which is to "distribute electronic portable high content-quality documents to many recipients in a controlled, economical and accountable fashion..." (see col. 2, lines 15-18). Since *Smith* does not disclose all of the features of claim 11, Applicants respectfully submit that the rejection to claim 11 be withdrawn.

Because independent claim 11 is allowable over *Smith*, dependent claims 12-16 are allowable as a matter of law.

Independent Claim 17

With regard to independent claim 17, Applicants respectfully submit that *Smith* does not disclose, teach, or suggest ***logic configured to configure the document for a single use***, as recited in claim 17. The system in *Smith* describes a private uniform resource locator (PURL) that is temporary, dynamically generated, and that uniquely identifies the intended recipient of a document and the document itself. (see col. 15, lines 9-15). In particular, *Smith*

states that the "server dynamically generates a URL for <u>each intended recipient of the</u> <u>document</u>." (see col. 15, lines 32-34; emphasis added). Clearly, the document is not configured for *a single use* if more than a single user can access it. The ability to provide multiple access to the document is consistent with one of *Smith*'s stated purpose, which is to "distribute electronic portable high content-quality documents to many recipients in a controlled, economical and accountable fashion…" (see col. 2, lines 15-18). Since *Smith* does not disclose all of the features of claim 17, Applicants respectfully submit that the rejection to claim 17 be withdrawn.

Because independent claim 17 is allowable over *Smith*, dependent claims 18-21 are allowable as a matter of law.

Independent Claim 22

With regard to independent claim 22, Applicants respectfully submit that *Smith* does not disclose, teach, or suggest *logic configured to implement the web server to configure the retrieved document for one-time use*, as recited in claim 22. The system in *Smith* describes a private uniform resource locator (PURL) that is temporary, dynamically generated, and that uniquely identifies the intended recipient of a document and the document itself. (see col. 15, lines 9-15). In particular, *Smith* states that the "server dynamically generates a URL for <u>each</u> <u>intended recipient of the document</u>." (see col. 15, lines 32-34; emphasis added). Clearly, the document is not configured for *one-time use* if more than a single user can access it. The ability to provide multiple access to the document is consistent with one of *Smith*'s stated purpose, which is to "distribute electronic portable high content-quality documents to many recipients in a controlled, economical and accountable fashion…" (see col. 2, lines 15-18). Since *Smith* does not disclose all of the features of claim 22, Applicants respectfully submit that the rejection to claim 22 be withdrawn.

Because independent claim 22 is allowable over *Smith*, dependent claims 23-26 are allowable as a matter of law.

Independent Claim 27

With regard to independent claim 27, Applicants respectfully submit that *Smith* does not disclose, teach, or suggest ***means configuring the retrieved document for single-use***, as recited in claim 27. The system in *Smith* describes a private uniform resource locator (PURL) that is temporary, dynamically generated, and that uniquely identifies the intended recipient of a document and the document itself. (see col. 15, lines 9-15). In particular, *Smith* states that the "server dynamically generates a URL for each intended recipient of the document." (see col. 15, lines 32-34; emphasis added). Clearly, the document is not configured for ***one-time use*** if more than a single user can access it. The ability to provide multiple access to the document is consistent with one of *Smith*'s stated purpose, which is to "distribute electronic portable high content-quality documents to many recipients in a controlled, economical and accountable fashion..." (see col. 2, lines 15-18). Since *Smith* does not disclose all of the features of claim 27, Applicants respectfully submit that the rejection to claim 27 be withdrawn.

Because independent claim 27 is allowable over *Smith*, dependent claim 28 is allowable as a matter of law.

Inherency/Obvious Rejection Traversals

Applicants also respectfully traverse the findings by the Office Action on inherency. The Office Action alleges the following on page 3, section c:

> It is inherent to the PURLs as defined by Smith that they are intended for a single use, and consequently would be deleted at some point in time after the document has been downloaded. This assertion is based on their temporary nature (column 15, lines 8-11) and that each PURL is intended for one specific user; when a document is sent to multiple users, multiple distinct PURLs are generated, one for each intended recipient (column 15, lines 34-38). If Applicant wishes to contest this assertion, a 103(a)

rejection will then be raised on the grounds that stipulating that a PURL be a single-use link that is invalidated after a successful download would have been an obvious feature for one of ordinary skill in the art at the time the invention were made to include. Given that the documents are only temporarily stored on the server (column 15, line 32), continuing to promulgate the PURL after the document it references has been removed from the server would serve no purpose except to potentially incur useless web traffic by someone trying to follow a dead link. In addition, leaving a PURL active after a download could potentially be a security risk; a webcrawler might stumble upon a PURL pertaining to a document the sender wished to remain confidential and publicly post the location of said document against the sender's wishes. Invalidating [deleting] the PURL immediately after a successful download would help prevent these situations from occurring.

Applicants respectfully disagree that it is inherent that the PURL is intended for single use. MPEP, section 2112, establishes that "in relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic <u>necessarily</u> flows from the teachings of the applied prior art." Applicants respectfully submit that, although the PURL in *Smith* is unique to an individual, that does not prevent the individual from repeated requests using the PURL assigned to him or her. Thus, it does not necessarily flow from *Smith* that the PURL is intended for single use.

Applicants respectfully disagree that "stipulating that a PURL be a single-use link that is invalidated after a successful download would have been an obvious feature for one of ordinary skill in the art at the time the invention were made to include." For example, in the *Smith* system, what if the user wanted to repeatedly access the document using the given PURL? Removing the PURL would prevent that from occurring, and such a mechanism would not be consistent with *Smith*'s system, which encourages wide, albeit controlled, distribution of the documents. Thus, it is not obvious that the PURL is for single use.

III. Claim Rejections - 35 U.S.C. § 103(a)

A. Statement of the Rejection - Claims 1, 2, 4-6, 3, 9, 14-15, 19 and 24-25

Claims 1-2 and 4-6 have been rejected under 35 U.S.C. § 103(a) as allegedly being

unpatentable over *Smith et al.* ("*Smith,*" U.S. Pat. No. 6,192,407). Claims 3, 9, 14-15, 19 and

24-25 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Smith*

as applied to claims 1, 7, 11, 17 and 22 above, and further in view of *Schneier.* ("*Schneier,*"

"Applied Crytograph," 2nd edition). Applicants respectfully traverse these rejections.

B. Discussion of the Rejection

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S.

Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a proper

case of obviousness by showing some objective teaching in the prior art or generally available

knowledge of one of ordinary skill in the art that would lead that individual to the claimed

invention. See *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

Accordingly, to make a proper case for obviousness, there must be a prior art teaching or

established knowledge that would suggest to a person having ordinary skill in the pertinent art to

fill the voids apparent in the applied reference. It is respectfully asserted that no such case has

been made in the outstanding Office Action.

Independent Claim 1

As provided in independent claim 1, Applicants claim (emphasis added):

1.   A method for a computer to deliver an electronic document to an
Internet appliance, the method comprising the steps of:
configuring a document for a one-time use;
receiving an access request for the document from the Internet appliance;
sending the requested document to the Internet appliance; and
deleting a single-use document address assigned to the requested
document after the requested document has been sent to the Internet
appliance.

Not every feature of independent claim 1 is represented in the *Smith* reference. In particular, *Smith* does not disclose *"configuring the document for a one-time use,"* as recited in independent claim 1. *Smith* states that the "server dynamically generates a URL for <u>each intended recipient of the document</u>." (see col. 15, lines 32-34; emphasis added). Clearly, the document is not configured for *one-time use* if more than a single user can access it. The ability to provide multiple access to the document is consistent with one of *Smith*'s stated purpose, which is to "distribute electronic portable high content-quality documents to many recipients in a controlled, economical and accountable fashion..." (see col. 2, lines 15-18). Since *Smith* does not disclose all of the features of claim 1, Applicants respectfully submit that the rejection to claim 1 be withdrawn.

Because independent claim 1 is allowable over *Smith*, dependent claims 2-6 are allowable as a matter of law.

The Office Action alleges the following in section 6 of the Action with regard to obviousness:

> Regarding claim 1, Smith teaches a system for document retrieval that features the ability to dynamically assign a single-use document address to the requested document, receiving an access request for the Internet appliance, and sending the document to the Internet appliance (column 15, lines 32-42). Note that PC as illustrated by element 320 of Figure 20 is an Internet appliance under the broadest definition of the term. In addition, while it is not explicitly stated that the dynamically generated URL is deleted after delivery of the document, Smith teaches that the URL is temporary (column 15, lines 8-11). It is therefore Examiner's contention that the single-use document address is deleted at a point in time after the requested document has been sent to the Internet appliance; but even if this were not the case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to do so. Note that the document is only temporarily stored on the server (column 15, line 32) so continuing to promulgate the dynamically generated URL after the document it references is removed from the server would serve no purpose except to potentially incur useless web traffic. Deleting the URL would prevent this situation from occurring. Smith also appears to be silent regarding a request for the document address; however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention disclosed by Smith such that the URL sent by email to the recipient (column

15, lines 38-41) instead contains a PURL that, when followed, generates a request for a PURL to the desired document. It is well known by those in the art that email can be retained for extended periods of time; so by adding a layer of indirection to the process, a server administrator can ensure that PURLs to documents stored on the server are not retained in any user's mailbox but are truly deleted.

It may be possible that the single-use address is temporary because the address may be deactivated in other ways besides deletion, thus the inherency does not necessarily follow. Accordingly, since it is not inherent, and other mechanisms are available, Applicants respectfully submit that a prima facia case of obviousness has not been established in the absence of documentary evidence. Certainly if it is so obvious to delete an URL, a reference can be provided to establish this assertion. Otherwise, Applicants respectfully request that the rejection be withdrawn.

Additionally, Applicants are confused about the line of reasoning to support the obviousness of requesting a document address, and thus traverse the finding of obviousness. However, the amendments to claim 1 render the Office Action arguments and reasoning moot.

Dependent Claims 3, 9, 14-15, 19, and 24-25

Since *Smith* does not disclose, teach, or suggest all of the claimed features found in claims 1-28, and since *Schneier* does not remedy these deficiencies, Applicants respectfully submit that the rejection to claims 3, 9, 14-15, 19, and 24-25 be withdrawn.
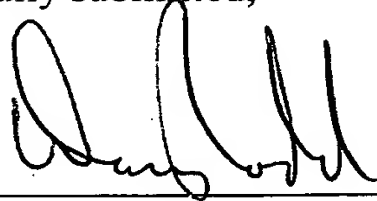
IV.   Canceled Claims

As identified above, claims 29-36 have been canceled from the application through this Response without prejudice, waiver, or disclaimer. Applicants reserve the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

CONCLUSION

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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